

REMARKS

Claims 1-6, 8-14 and 16-35 are pending. Claims 1-6, 8-14 and 16-35 are rejected. The first instance of claim 30 has been previously canceled; the second instance of claim 30 is currently pending.

Amendments to the Claims

Claims 1, 10, 12-14, 16-20, 23, 25 and 27-35 are amended with merely clarifying amendments. Support for these amendments may be found throughout the specification.

Claim 6 is canceled without prejudice or disclaimer.

Claims 36-38 are newly added. Support for these claims may be found throughout the specification.

No new matter is added.

Claim Rejection - 35 U.S.C. 112

The Examiner has rejected claims 20-32 and 35 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that "There is no disclosure, mention or suggestion of a user being able to set up a new parallel channel".

It is submitted that the above feature is disclosed in the specification at least at page 8, lines 11-14 ("At step 116, the processor controls the sending of the data message by the selected delivery mechanism using the destination address determined at step 110. The data message is sent via **a new channel that runs in parallel** with the voice channel used for the telephone call" (emphasis added)).

More detail is provided at page 7, lines 7 – 15 ("When the "send to caller" option is selected at step 108, the processor 30 at step 110 automatically determines a destination address for the data message using the identifier data stored at step 102... The database associates different telephone numbers with the data delivery addresses of different persons"). The determined destination address referred to in this section is a data delivery address for communications which may use, for example, email or Bluetooth as delivery mechanisms. The Bluetooth delivery mechanism, for example, is different to the delivery mechanisms used for phone calls. Therefore when data is sent via Bluetooth, it is sent via a different channel to that used for the phone call.

As the phone call and the Bluetooth communication happen simultaneously, the new channel can be referred to as a parallel channel. In view of this it is asserted that “a new channel which runs in parallel with a voice channel” is sufficiently well described in the specification.

Additionally, one skilled in the relevant art would be able to appreciate that the “processor” which “controls the sending of the data message” would be able to “set up” the channel over which the message is sent.

For at least these reasons, the specification reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, were in possession of the claimed invention. Therefore, the Applicants respectfully request the Examiner withdraw the rejection base on 35 U.S.C. 112, first paragraph.

Claim Rejection - 35 U.S.C. 103(a)

The Examiner has rejected claims 1-6, 8-14, 16-19 and 33-34 as being unpatentable under 35 U.S.C. 103(a) over Lin et al. (U.S. Patent Pub. No. 2005/0096071), herein Lin, in view of Lielbriedis (U.S. Patent Pub. No. 2001/0051528), herein Lielbriedis, and in view of Paik et al. (U.S. Patent Pub. No. 2008/0153471), herein Paik. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-5, 8-14, 16-19 and 33-34.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.¹

¹ *In Re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

In response to the above rejections, Applicant hereby submits a Rule 131 declaration signed by each inventor and Exhibits A through E (where Exhibits A and B form part of the declaration and which are redacted in order to protect personal information). Supplementary to the declaration and those exhibits, the undersigned attests that the invention report (of which Exhibit A forms a part) was submitted to outside counsel by email dated September 11, 2003 for the purposes of drafting a new patent application, and that the outside counsel corresponded with the inventors during each of September, October and November 2003 in drafting and refining the present application, which was filed in the USPTO on November 25, 2003 and claiming priority to November 22, 2003.

A reference may be shown as failing to qualify as prior art under 35 U.S.C. § 102(e) by antedating the effective date of the reference. See M.P.E.P. §§ 706.02(b) and 2136.05. A prior art patent may be sworn behind under 37 CFR § 1.131 by a showing of facts sufficient to establish a completion of the invention in this country before the filing date of the application on which the U.S. patent issued. "The showing of facts shall be such, in character and weight, as to establish ... conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application." 37 CFR § 1.131(b).

The "invention" refers to the subject matter of the claims. The purpose of the Rule 131 showing is to broadly establish possession of the invention. A Rule 131 declarant need not necessarily show possession of the entire invention as later claimed; it is sufficient that he shows possession of enough to make the entire invention obvious to one of ordinary skill in the art. See *In re Spiller*, 500 F.2d 1170, 1176, 182 USPQ 614, 618-19 (CCPA 1974).

The undersigned attorney asserts the following statements, acknowledging that they are true or are made on information and belief that is believed to be true; that any willful false statements are punishable by fine or imprisonment, or both, in accordance with 18 U.S.C. § 1001; and that such false statements may jeopardize the validity of any patent that may issue from the subject

application to which these assertions pertain.

A draft of the application (Exhibits D and E) was prepared by the law firm Swindell & Pearson by October 22, 2003 (per Exhibit C), and subsequently the finalized application was filed with the US Patent Office on November 25, 2003.

“[D]ecisions (as to the order in which a patent attorney prepares cases) recognize that the pressure of other business on a patent attorney may be a sufficient excuse for delay in filing provided the attorney takes up work in a reasonable order...” Chisum on Patents, vol 3, ch. 10.07[4][e] (Matthew Bender & Co., Inc., Rel. 82-3/02). See also, Gould v. Schawlow, 150 USPQ 634 (CCPA 1966); Rines v. Morgan, 116 USPQ 145, 148 (CCPA 1957) (“it is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved; and if the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient.”).

The attached declaration and supporting documentation show conception at least as early as September 11, 2003 (Exhibits A and B). That conception date precedes Lin (November 04, 2003). Diligent reduction to practice is shown through Exhibits C through E. Exhibits D and E, dated by email (Exhibit C) on October 22, 2003, indicates a continued attempt to prepare the application for filing.

In view of all of the above, diligence is shown from a date prior to the Lin priority date of December 17, 2004 (September 11, 2003 per Exhibit B) through the filing of the instant application on November 25, 2003. Therefore, Lin is not valid prior art against this application

In light of the above and the attached affidavit and exhibits, the Applicant contends that claims 1-5, 8-14, 16-19 and 33-34 are patentable as the cited art (Lin) is not valid against them.

Regarding claim 1 , which recites:

“A method comprising:
in a terminal of a first party participating in a telephone call, storing, as a
consequence of the telephone call, identifier data that identifies a second party

participating in the telephone call;

using the stored identifier data to determine automatically a **destination address** for a data message; and

controlling a transmitter to send, during the telephone call, a data message with the automatically determined **destination address**" (emphasis added).

The Examiner asserts Paik teaches:

"a caller identifier detecting unit which detects an identifier of an originating mobile terminal, a control unit which controls storage of the caller identifier information, and a call identification generation unit. The **identifier managing unit 45 manages the identifier** of the respective mobile terminal [sic] in the form of a **database** under the control of the control unit. (Para 45-47)" (emphasis added).

Assuming, arguendo, that the Examiner is correct, this discloses storing "caller identifier information". There is no disclosure or suggestion that "caller identifier information" is analogous to a "destination address" which may be used to send "during the telephone call, a data message" as in claim 1. Rather, as disclosed in Paik, the purpose of the network-based search is to retrieve identification information **identifying the mobile station which originated a communication**. This teaches against where identifier data is used to determine a destination address for data as in claim 1.

In light of the discussion above, the Applicant respectfully asserts that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 1-5, 8-14, 16-19 and 33-34.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

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Respectfully submitted:



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12/3/09

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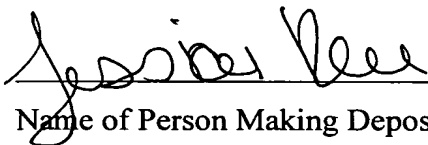
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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